

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. DeLEON and
JAMES W. OWENS

Appeal No. 97-1777
Application 08/328,708¹

ON BRIEF

Before COHEN, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Michael R. DeLeon et al. appeal from the final rejection of claims 1 through 11. Claims 12 through 14, which have been indicated as reciting allowable subject matter,

¹ Application for patent filed October 25, 1994.

stand objected to as depending from a rejected base.² Claim 15, the only other claim pending in the application, stands allowed.

The invention relates to a device for disposing a ladder adjacent a roof without contacting, and possibly damaging, the edge of the roof or a rain gutter associated therewith. Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. An apparatus for securing ladders against buildings and protecting rain gutters comprising a rear wall-mountable bar having a left end and a right end, a front ladder contacting and supporting bar having a first end and a second end, a left cross-member connected to the rear bar proximate to the left end and to the front bar proximate to the first end, a right cross-member connected to the rear bar proximate to the right end and to the front bar proximate to the second end, a left guide extending outward from the first end of the front bar, and a right guide extending outward from the second end of the front bar.

The references relied upon by the examiner as evidence of anticipation and obviousness are:³

Wigington	4,813,515	Mar. 21, 1989
Aarons,	493,868	Feb. 9, 1978

² The term “the O-ring” in claim 14 lacks a proper antecedent basis, an informality which is deserving of correction in any further prosecution before the examiner.

³ Although the examiner makes reference to U.S. Patent No. 5,215,163 to Kent, Sr. et al. on page 4 in the main answer to support his position, this patent has not been included in the statement of any of the rejections on appeal. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered the teachings of Kent, Sr. et al. in reviewing the merits of the examiner's rejections.

Australian Patent Document

The claims on appeal stand rejected as follows:

- a) claims 1 through 4 and 7 under 35 U.S.C. § 102(b) as being anticipated by Aarons;
- b) claims 1, 4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Wigington;
- c) claims 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Aarons or Wigington; and
- d) claims 8 through 11 under 35 U.S.C. § 103 as being unpatentable over Aarons in view of Wigington.

Reference is made to the appellants' main and reply briefs (Paper Nos. 9 and 11) and to the examiner's main and supplemental answers (Paper Nos. 10 and 12) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Aarons discloses "apparatus for protecting gutters on roofs from damage caused by the pressure of a ladder against the outer side of the gutter during roofing or other building operations" (page 2). The apparatus "may be made of metal or may be moulded in plastic provided adequate strength and rigidity are maintained" (page 4).

Aarons describes the apparatus as follows:

Referring first to FIG. 1, an angle-iron bar 10 has L-shaped forwardly-extending rigid side pieces 11 at each end, an inverted hook 12 being attached to the top of each upright of side pieces 11. A transverse support member 13, also in the form of an angle-iron bar, joins the outer ends of hooks 12. Short horizontal extensions 14 of hooks 12 extend beyond support member 13.

The length of bar 10 and support member 13 are such that a ladder of any normal width may be placed between extensions 14.

As shown in FIG. 2, the bracket is placed in a gutter 15 with bar 10 against the lower rear part of the gutter and the hooks 12 passing over the front edge 16 of the gutter. It will be noted that the bracket is so dimensioned that hooks 12 do not contact edge 16.

A ladder 17 is shown supported by support member 13 and lying between extensions 14.

Force from ladder 17 is exerted directly through bar 10 of the bracket against the rear inside surface of the gutter, backed by fascia 18 attached to roof rafter 19 and not on any other part of the gutter 15. No damage to the gutter structure or paint can therefore occur. Extensions 14 prevent the ladder moving sideways off the bracket [page 3].

Wigington "relates to a device for reinforcing and protecting a gutter with a ladder leaning against the gutter" (column 1, lines 5 through 7). In Wigington's words,

[a] gutter guard device (A) is disclosed which includes an elongated, tubular frame (B) formed by a rolled and stamped sheet metal construction. The stamping process defines transverse bracing webs (30) and vertical flanges (32) which brace between front and rear tubular braces (10, 14). Pivotal legs (22, 24) carried by frame (B) allow for easy installation of the guard in a gutter (12). Spaced indicator brackets (26, 28) assist the support of the front of the frame while providing visibility to determine location of the frame from the ground. A ladder may be leaned against the gutter between the indicator

tabs [Abstract].

With regard to the standing 35 U.S.C. § 102(b) rejection of claims 1 through 4 and 7 as being anticipated by Aarons, the appellants' contention that "none" of the features recited in these claims is taught or suggested by Aarons (see pages 5 and 6 in the main brief) is completely lacking in merit. Suffice it to say that the bar 10, support member 13, side pieces/hooks 11, 12, and extensions 14 of the Aarons' metal or plastic apparatus fully meet all of the limitations in these claims including those relating to the rear wall-mountable bar, front ladder contacting and supporting bar, left and right cross-members, and left and right guides, respectively. The appellants' more specific argument that their invention differs from the Aarons device in that it does not contact the gutter at any point and does not require any transverse member to abut the gutter (see, for example, page 7 in the main brief and page 2 in the reply brief) is not persuasive because it is not commensurate with the relatively broad scope of claims 1 through 4 and 7. More particularly, none of these claims excludes contact between the claimed device and a gutter.⁴ Thus, the appellants' position that the subject matter recited in claims 1 through 4 and 7 differs from that disclosed by Aarons is not well taken.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 1

⁴ Indeed, the appellants' specification indicates that when the claimed device is used with a gutter, its rear bar 3 will make contact therewith (see pages 5 and 7).

through 4 and 7 as being anticipated by Aarons.

The appellants' sole argument with respect to the standing 35 U.S.C. § 102(b) rejection of claims 1, 4, 7 and 8 as being anticipated by Wigington is that "[n]othing in Wigington teaches or describes the unique gutter saver of the present invention that does not abut the gutter nor does it require placement within the gutter. Thus, Wigington lacks crucial elements of the present invention" (main brief, page 8). This argument is not persuasive because it is not commensurate with the actual scope of the rejected claims, none of which excludes the recited apparatus from abutting or being placed in a gutter.

Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 4, 7 and 8 as being anticipated by Wigington.

We also shall sustain the standing 35 U.S.C. § 103 rejection of claims 5 and 6 as being unpatentable over Aarons or Wigington.

Claim 5 depends from claim 1 and requires the rear bar to be fitted with fasteners for connecting the apparatus to a fascia board or a rafter end under a roof of a building. Claim 6 depends from claim 1 and requires multiple holes to be positioned in the rear bar for receiving nails or bolts for fastening the apparatus to the fascia board

or rafter end. The appellants have not specifically disputed the examiner's conclusion that to provide the rear bar of the Aarons or Wigington apparatus with "holes as a fastening means and fasteners as desired would have been an obvious mechanical expedient" (main answer, page 2).

Finally, we shall sustain the standing 35 U.S.C. § 103 rejection of claims 8 through 11 as being unpatentable over Aarons in view of Wigington.

These claims depend from claim 1 and further define the claimed apparatus as having first and second cross-rails. According to the examiner,

Aarons shows the claimed apparatus with the exception of the cross rails. Wigington shows cross-rails at (16,30), configured identical to his cross-members, to enhance rigidity of his apparatus. It would have been obvious to one of ordinary skill in the art to modify Aarons to comprise inner cross members [sic, rails] as his outer cross members (12) to enhance rigidity of his apparatus [main answer, page 3].

The appellants contend this rejection is unsound because the proposed combination of Aarons and Wigington is based on impermissible hindsight and because the interior braces or cross-rails of the Wigington apparatus could not be physically incorporated into the Aarons apparatus (see, for example, page 12 in the main brief and page 3 in the reply brief).

The test for obviousness, however, is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Here, Wigington's disclosure of a ladder mounting apparatus having interior braces or cross-rails would have furnished the artisan with ample suggestion to provide the Aarons apparatus with interior cross-rails, suitably shaped in conformance with Aaron's cross-members 11, 12, to improve its strength and stability. As so modified, the Aarons apparatus would meet all of the limitations in claims 8 through 11.

In summary and for the above reasons, the decision of the examiner to reject claims 1 through 11 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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James C. Wray
1493 Chain Bridge Road
Suite 300
McLean, VA 22101